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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,674	08/07/2003	Tohru Hashioka	10404/16	1782

7590 11/25/2005
KENYON & KENYON
Suite 700
1500 K Street, N.W.
Washington, DC 20005

EXAMINER

NAKARANI, DHIRAJLAL S

ART UNIT PAPER NUMBER

1773

DATE MAILED: 11/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/635,674

Applicant(s)

HASHIOKA ET AL.

Examiner

D. S. Nakarani

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 2, 4-9 and 13 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a petroleum resin having softening point from 110°C to 150°C, does not reasonably provide enablement for petroleum resin having softening point less than 110°C. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The invention as claimed reads on petroleum resin having softening point less than 110°C. As per disclosure when petroleum resin has softening point less than 110°C film becomes tacky and whitens over time (Page 12, lines 18-21).
3. Claims 10-12 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a petroleum resin having softening point from 110°C to 150°C and present in an amount of 5 to 40 wt% based on a blend of propylene base resin and petroleum resin (see page 12, lines 11-21 and page 15, lines 8-23, does not reasonably provide enablement for petroleum resin having softening point less than 110°C and amount less than 5 wt% and higher than 40 wt%. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Art Unit: 1773

The invention as claimed reads on any petroleum resin and in an amount little less than 99 wt%. There is no evidence showing that e.g. 99 wt. part of mixture comprising (A) 1 wt% polypropylene base resin and (B) 99 wt% petroleum resin will result in claimed heat shrinkable polyolefin base film.

4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peiffer et al (U. S. Patent 5,573,717) for the reasons of record set forth in paragraph 7 of the Office Action mailed February 28, 2005 (Paper No. 20050207).

5. Applicant's arguments filed September 6, 2005 have been fully considered but they are not persuasive. In reference to rejection of claims 1-5 under 35 USC §103(a) as being unpatentable over Peiffer et al (U. S. Patent 5,573,717), applicants mainly argue that the claimed has a percentage of thermal shrinkage of at least 50% at 95°C x 10 seconds in the primary stretching direction of the film and a spontaneous shrinkage of less than 0.5% in a direction perpendicular to the primary shrinking direction after one week at 40°C. Peiffer et al disclose a process for producing a non-transparent oriented polyolefin film. Applicants have filed declaration of Norimi Tabota under 37 CFR 1.132 showing that Peiffer et al's film of Example 1 does not have claimed percentage of shrinkage.

These arguments are unpersuasive because all claims are not limited to argued thermal shrinkage of at least 50% at 95°C x 10 seconds. The declaration of Norimi

Tabota does not compare closest prior art film of Example 5. The claimed shrink film does not required to be transparent.


6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is (571) 272-1512. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


D. S. Nakarani
Primary Examiner
Art Unit 1773

Dsn
November 20, 2005.